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| 10/572,930 | 03/22/2006 | Robert Linley Muir | 17499US01 | 4948 |
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| 01/07/2009 | | | | |
| EXAMINER | | | | |
| AHMED, MASUD | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/572,930

Applicant(s)

MUIR, ROBERT LINLEY

Examiner

MASUD AHMED

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2006 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

Claims 1-63 are objected to because of the following informalities: A preliminary amendment was received from the applicant on 3/22/2006, however it seems that the part of the claim 1 was separated from the claim sheet into the applicant's preliminary amendment sheet. Applicant is respectfully requested to put all the claims in claim sheet and separating it from the preliminary amendment or remarks sheet in response to this office action. Appropriate correction is required.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 53 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 53 partially recites "***pre-programmed criterion is number gaming machines in play***", is very unclear to the examiner what exactly applicant meant by the above claim recitation. A further clarification is needed in the claim language for the better prosecution on the merit of this application.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-9, 13-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider et al (2003/0078101).

Regarding claims 1, 13, 18 Schneider teaches a network game system having following limitations:

A gaming system comprising a gaming server, a plurality of gaming machines, and a communications system connecting each of the plurality of gaming machines to the gaming server (para 0016),

the gaming machines each having a display a player interface, and a game controller arranged to control images displayed on the respective display, the gaming system operable to track play of games played by a plurality of players on the gaming machines and the game controller being arranged to play a game initiated by the a player at a said gaming machine (FIG 2 and para 0017),

the game being one of a plurality of games available on the gaming machine and selectable by the player and the game having a game result which, if it is a winning result, will cause the game controller to award a prize to the player, wherein each said gaming machine includes a game selector, which displays a selection of games available on that gaming machine for the player to play (para 0056),

the selection being determined dependent on the player's past history of playing games and a history of games played by other players (para 0038 and 0056). However Schneider is silent on disclosing the game selection is based on the history of games played by others, multiple games screen option on a game machine is well known in the art and as Schneider disclosure these games can be selected by the players previous playing history and preferences, it should be noted that Schneider is trying to solve the same problem what applicant's claiming to solve, which is offer players games according to their preferences based on previous record and history of the game play, therefore it would have been obvious to ordinary skilled artisan at the time of invention to use other people's game playing history as a determination factor for player selection of the games as the game is designed to meet the player's need.

Regarding claims 2-3, 14, 19, Schneider discloses the central database records players game playing history of every game played along with other possible interaction with the game playing machines are recorded on the database (para 0027, 0032).

Regarding claims 4-5, 15, 20, As cited and rationale provided by the examiner on claim 1, all the patrons game play history is recorded in a central database and can be identified by patron's identification, therefore as disclosed on para 0027 and 0032, every games played in the machine or in the system are captured or recorded to provide the

players are with particular types of games they like to play or simply provide the players with popular games played by others.

Regarding claims 6-7, 21-22, Schneider disclosed the games are tailored or provided upon collecting player's game history data by a recommendation engine in the system (para 0038), further examiner believes a recommendation engine being on the gaming machine itself or within the gaming network is an obvious design choice and this feature is not patentably distinct from one another.

Regarding claims 8-9, Schneider discloses recommendation engine connected in a network that collects data from every player playing habits along with others statistical information (para 0038-0042), based on these information players are provided with the customized games or tailored games to suit their needs

3. Claims 10-12, 16-17, 23-25, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider et al (US 2003/0078101), in view of Paulsen (US 2002/0142846).

Regarding claims 10-12, 16-17, 23-25, 26, 33-35, 42, As disclosed by Schneider on the above claims that various player's information is captured or recorded to tailor the

games accordingly when players are identified, though it can be conclude from Schneider's disclosure that the popular games are recommended based on the players historical data, however examiner believes to establish the obviousness showing to the applicant, applicant is entitled to receive an evidence for the obviousness allegation, therefore examiner draws applicant attention to the Paulsen (para 0011-0017), wherein Paulsen discloses various aspects of the invention including customizing games and providing popular or preferred games to the players based on the previously collected players data and selections of the games among various groups of games, therefore it would have been obvious to ordinary skilled artisan at the time of invention to use Schneider's players historical data information to provide players with the popular games that are played by many players as an additional option to the other selectable games.

Regarding claim 27, Schneider discloses the central database records players game playing history of every game played along with other possible interaction with the game playing machines are recorded on the database (para 0027, 0032).

Regarding claim 28, As cited and rationale provided by the examiner on claim 1, all the patrons game play history is recorded in a central database and can be identified by patron's identification, therefore as disclosed on para 0027 and 0032, every games played in the machine or in the system are captured or recorded to provide the players

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are with particular types of games they like to play or simply provide the players with popular games played by others.

Regarding claims 29-32, Schneider discloses recommendation engine connected in a network that collects data from every player playing habits along with others statistical information (para 0038-0042), based on these information players are provided with the customized games or tailored games to suit their needs.

Regarding claim 36, As disclosed on claim 1 that the various selection of the games to be selected on a game machine is well known in the art, however Paulsen disclosed various types of games and categories are provided to the players based on their playing history and selectable by the players (para 0011-0017), a further rationale is provided in claims 10-12 above.

Regarding claims 37-38, Paulsen further discloses games are split into number of categories and preferably can be selected by the players such as poker, video slots, game version, game color schemes and pay tables (para 0013).

Regarding claims 39-41, Paulsen also discloses various games can be selected from different categories by the players using various selection methods such as button panel or touch screen buttons (para 0014), a game that is categorized to be with more than one groups of game is simply a design choice of the game menu, for example a bingo and a slot games often times can be categorized as class II games which falls within either slot or bingo games.

Regarding claim 43, Paulsen teaches various categories of games are offered to the players according to their game playing history (para 0013-0014), it is understood from the disclosure that the games are offered on the menu would be extends to the further menu selection page if it is not adequate display space on the display screen.

Regarding claims 44-49, As disclosed above both Schneider and Paulsen discloses providing players with the selections of games according to their game playing history or another word customizing games , theme of the game or even category of the games in accordance with the game play history collected by the system database previously identified the player tracker unit, therefore it is needless to say that a filter is provided within the system to filter out the un-popular games to display to the player game selection option, further it is within the knowledge of ordinary skilled artisan to modify the program logic within the selection menu to extend or shorten the game selection menu and also categorize the games as played by the players previously.

Regarding claims 50-53, Schneider teaches games are selected dynamically or by default upon players identification and according to the player history data (para 0056), which is considered to be a pre-programmed criterion, additional criterions are simply an alternatives to Schneider's and Paulsen's disclosure.

Regarding claim 54, Schneider discloses plurality of games can be accessed from the various machines (para 0013).

Regarding claims 55-57, Schneider discloses win/loss recording factor as a part of the game history capturing can play a role in customizing or tailoring the game for the preferred users (para 0045), which can be considered as ranking of the player and presenting the game options accordingly, further Schneider discloses certain demographics such as players age as a determination factor (para 0046).

Regarding claim 58, In addition to the teachings of claim 1, a recommendation engine is addressed by the examiner on claim 8-9 and 10-12 above.

Regarding claims 59-61, Schneider and Paulsen both teaches the games are tailored or customized according to the players game playing history of certain characteristic as disclosed above, applicant's claim of gaming machine to compute a value indicative of the likelihood of that player most likely would play the game is simply a logical expression of providing players with the games that previously played by the players or preferred by the players.

Regarding claim 62, In addition to the teachings of claim 1, examiner has provided rationale above on claim 10-12 to establish the obviousness of the popular games to be provided to the players as a recommendation.

Regarding claim 63, In addition to the teachings of claim 1, Schneider teaches the ranking of the player as a factor of providing players with the popular choices as disclosed on claims 55-57 above.

Applicant is respectfully advised to review the entire prior art of record very closely as they are very closely related to make the patentable distinctions.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MASUD AHMED whose telephone number is (571)270-1315. The examiner can normally be reached on Mon-Fri 10:00am-7:00pm, Alt Fri, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571 272 4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John M Hotaling II/
Supervisory Patent Examiner, Art Unit 3714

/M. A./
Examiner, Art Unit 3714